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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,131	05/01/2001	William Henry Elfring	A01047	7880

21898            7590            03/11/2003  
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EXAMINER	
REDDICK, MARIE L	
ART UNIT	PAPER NUMBER

1713  
DATE MAILED: 03/11/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	<b>Application No.</b> 09/846,131	<b>Applicant(s)</b> ELFRING ET AL.
	<b>Examiner</b> Judy M. Reddick	<b>Art Unit</b> 1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
   
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
   
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
   
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
   
 - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 23 December 2002.
   
 2a) This action is FINAL.      2b) This action is non-final.
   
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1, 2 and 4-8 is/are pending in the application.
   
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
   
 5) Claim(s) \_\_\_\_\_ is/are allowed.
   
 6) Claim(s) 1, 2 and 4-8 is/are rejected.
   
 7) Claim(s) 2, 4 & 8 is/are objected to.
   
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.
   
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
   
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   
 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
   
 If approved, corrected drawings are required in reply to this Office action.
   
 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   
 a) All b) Some \* c) None of:
   
 1. Certified copies of the priority documents have been received.
   
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
   
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   
 \* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
   
 a) The translation of the foreign language provisional application has been received.
   
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)
   
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
   
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
   
 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
   
 5) Notice of Informal Patent Application (PTO-152)
   
 6) Other: \_\_\_\_\_.

**DETAILED ACTION****Claim Objections**

1. **Claims 4 & 8 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 4/3 is dependent from a canceled claim, viz., claim 3 and claim 8/9 is dependent from a non-existent claim, viz., claim 9 with the understanding that the claim currently pending in the instant application are claims 1, 2 and 4-8.**
2. **Claims 2 & 4 are objected to because of the following informalities: "The improved elastomeric coating" per the preamble of each of the claims supra should read "The exterior elastomeric coating" so as to engender claim language consistency. Appropriate correction is required.**

**Claim Rejections - 35 USC § 102**

3. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

**The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).**

4. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

5. **Claims 1, 2 and 4-8 stand rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Park et al(U.S. 6,255,381) as per reasons stated in the previous Office Action per paper no. 4, 09/17/02. Further, it would be expected that the coating compositions of Park et al would possess elastomeric properties, based on the low glass transition of the polymers. Moreover, it would be expected that the coating compositions of Park et al would possess elastomeric properties since the coating compositions of Park et al overlap in scope with the claimed coating compositions as provided for under the guise of In re Best et al(195 USPQ 430). As to the utility of the composition of Park et al as an exterior coating, it is believed that the coating on a packaging box(col. 6, lines 1-3 of Park et al) is sufficient to meet the "exterior coating" limitation per the claimed invention. Even if this turned out not to be the case, the discovery of a new property or use for a previously known compound(composition) cannot impart patentability to claims to that compound(composition), even if the property or use is unobvious from the prior art as provided for under the guise of In re Schoenwald, 22 USPQ 1671. As to the claimed volume ratio of from 1.6:1 to 95:1(claims 1 & 7) and 1.6:1 to 9:1(claims 4 and 8), in terms of organic binder: particulate organic polymer, the ratio recited in the paragraphing bridging cols. 4 and 5, clearly overlaps in scope with the claimed ratio, according to the Examiner's calculations. Further note that although the use of 0.03 to 12 wt. parts in proportion to 100 parts of latex blend is taught as a preferable content for the inorganic compound, the inorganic compound is an optional component(col. 2, lines 47-53 and col. 5, lines 6-21). To this end, the limitation of "replacing at least a part of said one inorganic additive" per claim 5 is clearly met by Park et al with the understanding that the claims, in their present form, read as though the**

*in rganic compound was n ver there in the first place, viz., the claims also includ the result of combining only an organic binder and a solid particulate organic polymer.*

**Response to Arguments**

6. **Applicant's arguments filed 12/23/02 have been fully considered but they are not persuasive.**

**Relative to Park et al**—The crux of Counsel's extensive arguments appears to hinge on the non-teaching or suggestion of a) the volume ratio of an organic binder to a solid particulate organic polymer b) the non-replacement of at least a part of an inorganic additive with a solid particulate organic polymer and c) the use of the composition of Park et al as an exterior coating. To this end, all of the items argued have already been addressed per the rejection *supra* and need not be repeated here.

**Conclusion**

7. **THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).**

**A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.**

**Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..**

**If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the**

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**organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.**

**Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.**

*J. M. Reddick*

**Judy M. Reddick  
Primary Examiner  
Art Unit 1713**

*JMR Jm*

**March 10, 2003**